



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,107	11/25/2003	Miwa Kanamori	57810-083	4499

7590 07/06/2006

McDermott, Will & Emery
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

VUONG, QUOCHIE B

ART UNIT	PAPER NUMBER
----------	--------------

2618

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/720,107	KANAMORI ET AL.	
	Examiner	Art Unit	
	Quochien B. Vuong	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/551,219.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/03, 12/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 19-22, drawn to a portable telephone set comprising: talking means and music relay means, for superposing a talking voice of telephone communication on replayed music when making a telephone communication, classified in class 455, subclass 556.
 - II. Claims 23-25, drawn to replaying music corresponding to an interruption call from a third party during telephone communication and continuation of a connection state between three persons in a portable telephone set, classified in class 455, subclass 416.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group I has separate utility such as superposing a talking voice of telephone communication on replayed music when receiving a call during music replay; while invention Group II has separate utility such as replaying music corresponding to an interruption call from a third party when receiving the interruption call during telephone communication and superposing replayed music on a talking voice of the telephone communication and

Art Unit: 2618

continuation of a connection state between three persons in a call conference. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Applicant's representative Mr. Brian Seidleck on 06/13/2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 19-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-25 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on 11/25/2003 and 12/15/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 19 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Hofschen et al. (WO 99/00962 – English translation).

Regarding claim 19, Hofschen et al. discloses a portable telephone set (figure 1) comprising: talking means (microphone and speakers); and music replay means (SPM), for superposing a talking voice of telephone communication on replayed means when making the telephone communication through the talking means during the music replay by the music replay means (see abstract; and page 7, line 16 – page 10, line 5).

Regarding claim 21, Hofschen et al. disclose the portable telephone set capable of arbitrarily setting the volume of the talking voice of the telephone communication and the volume of the replayed music in the process of the music replay (page 9, lines 1-12; and page 10, lines 1-5).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofschien et al. in view of Chin (US 5,661,788).

Regarding claim 20, Hofschien et al. disclose the portable telephone set according to claim 19. Hofschien do not disclose telephone number storage means storing telephone numbers, and superposing the talking voice of the telephone communication on the replayed music in the process of the music replay by the music replay means when making the telephone communication with the telephone numbers stored in the telephone number storage means. However, Chin (figure 1) discloses telephone number storage means storing telephone numbers (figure 1, item 112) for selectively alerting the user of preferred telephone calls (see abstract, column 2, line 45 – column 3, line 3). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the telephone number storage means and the teaching of Chin to the portable telephone set of Hofschien et al. in such a way the portable telephone set superposing the talking voice of the telephone communication on the replayed music in the process of the music replay by the music replay means when making the telephone communication with the telephone numbers stored in the telephone number storage means so that the user can be selectively

Art Unit: 2618

alerted of the preferred incoming telephone calls as suggested by Chin (column 1, lines 50-53).

Regarding claim 22, Hofschien et al. and Chin disclose the portable telephone set of claim 20 above; in addition, Hofschien et al. disclose the portable telephone set capable of arbitrarily setting the volume of the talking voice of the telephone communication and the volume of the replayed music in the process of the music replay in correspondence to the telephone number stored in the telephone number storage means (page 9, lines 1-12; and page 10, lines 1-5).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



QUOCHIEN B. VUONG
PRIMARY EXAMINER

Quochien B. Vuong
June 15, 2006.